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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,993	03/24/2004	Andrew Fikes	16113-764001/GP-089-04-U	9878
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FISH & RICHARDSON P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER BOVEJA, NAMRATA	
			ART UNIT 3622	PAPER NUMBER
			NOTIFICATION DATE 12/19/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

## Office Action Summary

**Application No.**

10/808,993

**Applicant(s)**

FIKES ET AL.

**Examiner**

PINKY BOVEJA

**Art Unit**

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 1, 13, 14, 26 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-12, 15-25, 27 and 29-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 08/13/08.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

**/DETAILED ACTION**

1. This office action is in response to the RCE communication filed on 09/12/2008.
2. Claims 1, 13, 14, 26, and 28 have been cancelled. Claims 2-13, 15-25, 27, and 29-33 are presented for examination.
3. Applicant's amendments to the claims 2-4, 6, 7, 11, 15-17, 19, 20, 24, and 29-33 have been entered and considered.

**Claim Rejections - 35 USC § 101**

35 U.S.C. 101 reads as follows:

*Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.*

4. Claims 2-13, 15-25, 27, and 29-33 are rejected under 35 U.S.C. 101.

*In reference to claims 2-13, 15-25, 27, and 29-33 the invention is directed to a non-statutory subject matter that is non-functional descriptive material. Descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter. Certain types of descriptive material, such as a contract, music, literature, art, photographs, and mere arrangements or compilations of facts or data such as "storage include the first advertisement" and "stored advertisements include a description of at least one item", are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer, where such descriptive material alone does not impart functionality either to*

*the data as so structured, or to the computer. Such "descriptive material" including data such as "storage include the first advertisement" and "stored advertisements include a description of at least one item" are not a process, machine, manufacture, or composition of matter is therefore non-statutory. The claimed "data" elements are simply stored information. The "data" does not have any imparted functionality, it this data per se is therefore non-statutory material. Furthermore, such limitations do not alter the scope of the claims, since they do not further limit the claims. Also, no additional steps are required to differentiate these limitations from the prior art.*

**Claim Rejections - 35 USC § 112**

5. *The second paragraph of 35 U.S.C. 112 is directed to requirements for the claims:*

*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.*

*There are two separate requirements set forth in this paragraph:*

- (A) the claims must set forth the subject matter that applicants regard as their invention; and*
- (B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.*

*Claims 2-12, 30, and 32 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.*

*The claims recite a system comprising of an advertisement interface and an advertising creative interface, and this renders the claim indefinite, because a system typically comprises of hardware components and not a computer program or software.*

*So, it is unclear what the Applicant is trying to claim here. It is interpreted as a system for displaying the interfaces. Appropriate correction is required.*

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-13, 15-25, 27, and 29-33 are rejected under U.S.C. 103(a) as being unpatentable over Wagner et al. (Patent Number 7,062,466 hereinafter Wagner) in view of the Internet Archives print out of the Yahoo! Classifieds webpage from January 26, 2004 (hereinafter Yahoo) and further in view of Radwin (Patent Number 7,007,074 hereinafter Radwin).

In reference to claims 2, 15, and 29, Wagner teaches a method, system, and apparatus for providing on-line advertising comprising: *an advertisement interface for defining the appearance and content of a first advertisement using user advertisement inputs (col. 5 lines 54 to col. 6 lines 12, and Figure 3); an advertising creative interface (Figure 8) for defining the appearance and content of an advertising creative using user advertising creative inputs (col. 5 lines 54 to col. 6 lines 12, and Figure 3); advertisement storage for storing advertisements and advertising creatives defined using the advertisement interface, wherein stored advertisements of the advertisement storage include the first advertisement (col. 3 lines 45-50, col. 4 lines 39-41 and lines 64*

to col. 5 lines 39, and Figures 2 and 5); an indexer to identify one or more *stored* advertisements relevant to a query, wherein the identified advertisements *include a description of* at least one item (col. 8 lines 37 to lines 56 and Figures 8 and 9); and a targeting component to provide the advertising creative associated with *the first* advertisement as Web-based content on one or more targeted Web pages (col. 8 lines 37 to lines 56 and Figures 8 and 9).

Wagner does not specifically teach including a hyperlink reference to *a webpage of the first advertisement*. Yahoo teaches including a hyperlink reference to *a webpage of the first advertisement* (see under heading of Featured Listings, *each ad has a hyperlink reference to a webpage of each advertisement, i.e. "1996 Nissan Pickup"*). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify Wagner to include a hyperlink reference to *a webpage of the first advertisement* to enable the presentation of detailed advertisement information for a product on the page directed to by the hyperlink.

Wagner doesn't specifically teach a scorer to score the *stored* advertisements based on a measure of match between the query and the *description* of the identified *stored* advertisements. Radwin teaches a scorer to score the *stored* advertisements based on a measure of match between the query and the *description* of the identified *stored* advertisements (col. 7 lines 41 to col. 8 lines 24, col. 8 lines 40-59, col. 9 lines 4-39, col. 9 lines 65 to col. 10 lines 37, col. 14 lines 20-29, and Figure 5). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify Wagner to include a scorer to score the *stored* advertisements

based on a measure of match between the query and the *description* of the identified *stored* advertisements to enable the presentation of most relevant advertising to the user first followed by the least relevant information to save the user time in locating the most relevant advertising content.

7. In reference to claims 3 and 16, Wagner does not specifically teaches a method and system, wherein *the measure of match is represented by a numerical score and at least some of the identified advertisements are ranked by the numerical score*. Radwin teaches a system, wherein *the measure of match is represented by a numerical score at least some of the identified advertisements are ranked by the numerical score* (col. 7 lines 41 to col. 8 lines 24, col. 8 lines 40-59, col. 9 lines 4-39, col. 14 lines 20-29, and Figure 5). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify Wagner to *represent the measure of match by a numerical score and rank some identified advertisements by the numerical score to enable the presentation of most relevant advertising to the user first followed by the least relevant information and to save the user time*.

8. In reference to claims 4 and 17, Wagner does not teach a method and system further comprising: providing at least some of the *stored* advertisements as the Web-based content in response to selection of a hyperlink reference of *an* associated advertising creative. Yahoo teaches providing at least some of the *stored* advertisements as the Web-based content in response to selection of a hyperlink reference of *an* associated advertising creative, since it is inherent when a user clicks on the hyperlink for an advertisement, detailed *stored* information regarding the

advertisement is presented to the user on the web (page 1 see the section titled featured listings). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify Wagner to include a selectable hyperlink reference to the *stored* advertisement to enable the presentation of detailed advertisement information for a product on the page directed to by the hyperlink.

9. In reference to claims 5 and 18, Wagner teaches the method and system further comprising: targeting the advertising creative by associating one or more query terms with the item description (i.e. associating ad with car model type) (col. 8 lines 37-56 and Figures 8 and 9).

10. In reference to claims 6 and 19, Wagner teaches a method and system, further comprising: including at least part of the *description is included* in the advertising creative (col. 5 lines 54 to col. 6 lines 25, and Figure 3).

11. In reference to claims 7 and 20, Wagner teaches a method and system further comprising: an advertising creative generator to automatically generate the advertising creative *based on user advertising creative inputs* (col. 5 lines 54 to col. 6 lines 25, col. 6 lines 57 to col. 7 lines 9, col. 8 lines 50-56, and Figures 3, 4 and 9).

12. In reference to claims 8 and 21, Wagner teaches a method and a system further comprising: determining an advertising budget specifying compensation associated with the advertising creative (col. 6 lines 38 to col. 7 lines 9, col. 7 lines 66 to col. 8 lines 18, and Figures 3-5).

13. In reference to claims 9 and 22, Wagner teaches a method and system, wherein the advertising budget includes a budgeted compensation amount per unit of time (col.



6 lines 38 to col. 7 lines 9, col. 7 lines 66 to col. 8 lines 18, and Figures 3-5).

14. In reference to claims 10 and 23, Wagner teaches a method and system, further comprising: collecting compensation for on-line publication of the advertising creative in accordance with the advertising budget (i.e. it is inherent the advertiser's credit card is charged for the appropriate amount) (col. 5 lines 54-64 and Figure 3).

15. In reference to claims 11 and 24, Wagner teaches providing an advertising budget (col. 6 lines 38 to col. 7 lines 9, col. 7 lines 66 to col. 8 lines 18, and Figures 3-5). Wagner does not specifically teach the advertising budget based on at least one of per impression of the formatted advertisement, per click of the formatted advertisement and by a conversion of the at least one item. Radwin teaches providing an advertising budget for a cost per impression basis (i.e. per 1,000 matches or views) (col. 1 lines 19-38). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify Wagner to include the advertising budget based on at least one of per impression of the formatted advertisement to enable the presentation of advertisement based on a per impression basis instead of just based on the amount of time or the type of device on which the advertisement will be displayed, and to therefore offer the advertiser an even more customized forum for advertising.

16. In reference to claims 12 and 25, Wagner teaches a method and system, wherein the item description comprises at least one of text, an image, price, contact information, and payment information (col. 5 lines 54 to col. 6 lines 56 and Figure 3).

17. *In reference to claim 30, Wagner teaches the system wherein the advertisement interface is configured to present simulated advertisement content and appearance to a*

*user based on the user advertisement inputs (col. 5 lines 54 to col. 6 lines 25, and Figure 3).*

18. *In reference to claim 31, Wagner teaches the system wherein the simulated advertisement content and appearance are presented to the user as the user enters the user advertisement inputs (col. 5 lines 54 to col. 6 lines 25, and Figure 3).*

19. *In reference to claim 32, Wagner teaches the system wherein the advertisement creative interface is configured to present simulated advertisement creative content and appearance to a user based on the user advertising creative inputs (col. 5 lines 54 to col. 6 lines 25, and Figure 3).*

20. *In reference to claim 33, Wagner teaches the system wherein the simulated advertisement creative content and appearance are presented to the user as the user enters the user advertising creative inputs (col. 5 lines 54 to col. 6 lines 25, and Figure 3).*

#### **Response to Arguments**

21. After careful review of Applicant's remarks/arguments filed on 09/12/2008, the Applicant's arguments with respect to claims 2-13, 15-25, 27, and 29-33 have been fully considered but are moot in view of the new ground(s) of rejection. Amendments to claims 2-4, 6, 7, 11, 15-17, 19, 20, 24, and 29-33 have been entered and considered.

22. Applicant's amendment overcomes the 35 U.S.C. 112 2<sup>nd</sup> paragraph rejections that were previously raised for claims 2, 15, and 29. However, Applicant's amendments have caused the introduction of new 35 U.S.C. 101 and 35 U.S.C. 112 2<sup>nd</sup> paragraph rejections as detailed in the Office Action above.

23. Applicants additional remarks are addressed to new limitations in the claims and have been addressed in the rejection necessitated by the amendments.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The **FAX** number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on accessing the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).

/NAMRATA BOVEJA/

Examiner, Art Unit 3622